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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD ROBERT SCHEDIWY and FEDERICO FAGGIN

Appeal 2011-002122
Application 09/176,639
Technology Center 2600

Before KRISTEN L. DROESCH, KALYAN K. DESHPANDE, and
ERIC B. CHEN, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the non-final rejection of claims 24 and 52-96. Claims 1-23 and 25-51 have been cancelled. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

Appellants' invention relates to a touch pad module for an electronic device including a sensor layer, an insulative layer and a contiguous conductive layer. (Spec. Abstract.) The sensor layer, when used in conjunction with the insulative layer and the contiguous conductive layer, enables the touch pad module to sense both finger and stylus input data to the electronic device. (Spec. Abstract.)

Claim 24 is exemplary, with disputed limitation in *italics*:

24. A touch pad system comprising:

a sensor layer;

an insulative layer disposed over said sensor layer; and

a touch layer disposed over said insulative layer, *said touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object*, and wherein said sensor layer capacitively detects the image of said conductive object when said conductive object is placed proximate to said touch layer, *wherein the conductivity of said touch layer is configured to limit the size of said image to approximately four times the area of contact of said conductive object*.

Claims 24 and 52-96 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements.

With respect to independent claim 24, we are persuaded by Appellants' arguments (App. Br. 11-13; *see also* Reply Br. 2) that the newly added claim limitations "said touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact

of said conductive object” and “wherein the conductivity of said touch layer is configured to limit the size of said image to approximately four times the area of contact of said conductive object” are supported by the originally-filed Specification.

The Examiner found that “the specification does not adequately disclose how the ‘conductivity is configured to create an image of said conductive object that is larger than an area of contact of said conductive object’” (Ans. 4) and “the specification fails to accurately describe or define how a moderate conductivity is determined” (Ans. 5). We do not agree.

Appellants’ Specification describes a touch pad module including an electrode 503 and an insulating layer 502 covered by a moderately conductive layer 501. (Spec. 9:0-1; fig. 6.) The moderately conductive layer 501 can be “conductive carbon powder in a plastic carrier material such as epoxy.” (Spec. 9:3-4.) The Specification explains that “[b]y controlling the conductivity of layer 501, the perceived image size of the tip of the stylus can be adjusted to provide sufficient signal on an appropriate number of electrodes.” (Spec. 9:14-16.) The Specification also explains that “[i]f the conductive layer is too conductive, then the image will be very large, possibly even covering the entire surface of the touch pad” (Spec. 9:19-20; fig. 7), but “[i]f the conductive layer is not conductive enough, then the image will not be much larger than the tip of the stylus . . .” (Spec. 9:30-31; fig. 8). In a preferred embodiment, the Specification describes that the image size is “comparable to the width of a finger” (Spec. 12:4-6) or “approximately twice the width or diameter as that of a stylus” (i.e., an increase in area by a factor of four) (Spec. 12:9-12).

In other words, the Specification discloses that conductivity of the moderately conductive layer 501 can be configured by adjusting the concentration of conductive carbon powder in the plastic carrier material. (*See Spec. 9:3-4.*) Furthermore, the Specification explains that a moderate conductivity is determined by when the image size is “comparable to the width of a finger.” (*See Spec. 12:4-6.*) Therefore, Appellants’ Specification reasonably conveys to the artisan with ordinary skill that, as of the filing date of the application, the inventor had possession of the later claimed subject matter. *See Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991).

Thus, we do not agree with the Examiner that the Specification does not provide written description support for the claim limitations “said touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object” and “wherein the conductivity of said touch layer is configured to limit the size of said image to approximately four times the area of contact of said conductive object.”

With respect to independent claim 24, we are also persuaded by Appellants’ arguments (App. Br. 13-14; *see also* Reply Br. 2-3) that the Examiner erred in concluding that the limitations “said touch layer having a conductivity selected to create an image of a conductive object that is larger than an area of contact of said conductive object” and “wherein the conductivity of said touch layer is configured to limit the size of said image to approximately four times the area of contact of said conductive object” are not enabled by the Specification.

The Examiner concluded that “[t]he specification does not adequately disclose how the ‘conductivity is configured to create an image of said conductive object that is larger than an area of contact of said conductive object.’” (Ans. 6.) In particular, the Examiner found that “the specification does not teach how the conductivity is chosen or selected as claimed in the independent claims without undue experimentation.” (Ans. 6.) Again, we do not agree.

The Examiner has not alleged any amount of experimentation that would be required, much less demonstrated an amount that would be undue, pursuant to supporting the legal conclusion of an enablement rejection. *See In re Wands*, 858 F.2d 731, 737 (Fed. Cir. 1988) (listing the factual findings required to show undue experimentation and lack of enablement). Therefore, the Examiner has erred by not meeting the initial burden of demonstrating that independent claim 24 lacks enablement under 35 U.S.C. § 112, first paragraph.

Accordingly, we reverse the rejections of independent claim 24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description and enablement requirements.

Independent claims 52, 63, 68 and 88 recite limitations similar to those discussed with respect to independent claim 24. We reverse the rejection of claims 52, 63, 68 and 88, as well as claims 53-62, 64-67, 69-87 and 89-96, which depend from claims 52, 63, 68 and 88, for the reasons discussed with respect to claim 24.

DECISION

The decision to reject claims 24 and 52-96 is reversed.

Appeal 2011-002122
Application 09/176,639

REVERSED

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